

Application No. 10/735,392
Amendment dated November 30, 2006
Reply to Office Action of November 2, 2006

Docket No.: 66138-0005

REMARKS

Applicants are in receipt of the Notice of Non-Compliant Amendment dated November 2, 2006. Applicants inadvertently submitted an amendment using an earlier set of claims in the August 11, 2006 submission. A complete and accurate listing of claims has now been provided along with proper status identifiers.

This response is intended to fully responsive to the Non-Final Office Action dated April 11, 2006 and Applicants thank Examiner Safavi for his detailed review of the pending claims.

Claims 8-11 and 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 3-5, 8-11 and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese reference 10-292624 (JP '624). Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over either of Japanese reference 10-292624 (JP '624) or Sawyer '808 in view of European reference 623,434 (EP '434). Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese reference '624 (JP '624) in view of Edison '261.

At least for the reasons set forth below, Applicants respectfully traverse the foregoing rejections. Further, Applicants believe that there are also reasons other than those set forth below why the pending claims are patentable, and reserve the right to set forth those reasons, and to argue for the patentability of claims not explicitly addressed herein, in future papers.

I. Information Disclosure Statement

Applicants disagree that the information disclosure statement received on December 27, 2004 fails to fully comply with the provisions of 37 CFR 1.97 and MPEP § 609 because Applicants have failed to provide a date of publication for the reference listed as CA. The indicated reference is the international search report corresponding to the international application claiming priority to the same priority application as the present US application. The issue date of the international search report is on the document itself. Moreover, the Information Disclosure Statement itself

Application No. 10/735,392
Amendment dated November 30, 2006
Reply to Office Action of November 2, 2006

Docket No.: 66138-0005

specifically identifies the issue date of the international search report and the cited references as follows:

Applicant(s) have become aware of the following documents, cited in an International Search Report issued September 1, 2004, during the prosecution of international application no. PCT/US03/39745, which corresponds to the above referenced application, and in accordance with 37 CFR 1.97(c) and (e)(1) or (b)(3), hereby submit(s) these documents for the Examiner's consideration.

(Emphasis in original). Thus, to the extent necessary, it is requested that the Examiner consider the international search report.

I. Rejection of Claims 8-11 and 25-27 Under 35 U.S.C. §112

Claims 8-11 and 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner has objected to a number of the claims for including language along the lines of "a cavity associated with said pattern" suggesting it is not clear as to what is being defined. Applicants respectfully disagree. The language is clear on its face and is amply supported by the specification and figures. Nevertheless, to facilitate prosecution select claims have been amended to state that the pattern includes a cavity. Similarly, claims 9, 10, 26, and 27 have been amended to remove the word "may" to also facilitate prosecution. No detrimental alteration in claim scope is effected by the present amendments.

II. Rejection of Claims 1, 3-5, 8-11 and 24-27 Under 35 U.S.C. 102 – Japanese Reference 10-292624

Claims 1, 3-5, 8-11 and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese reference 10-292624 (JP '624). Applicants respectfully traverse the rejection.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or

Application No. 10/735,392
Amendment dated November 30, 2006
Reply to Office Action of November 2, 2006

Docket No.: 66138-0005

inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). “The elements must be arranged as required by the claim...” *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); also see MPEP § 2131.

Attached as Exhibit A is an English translation of JP ‘624. JP ‘624 does not anticipate the claimed invention.

Significantly, JP ‘624 teaches the use of a variety of materials and components to make box-shaped main mold form 2 in a multi-step non-molded process. First a form 100 is assembled. (Paragraph 0015 of the translation). Next a mold release treatment is performed. (Id.) Then a resin material is coated or sprayed on male pattern surface 103. (Id.). Before the resin material is completely cured, some type of reinforcing material is bonded to form a surface pattern layer. (Id.) Then using a composite resin or the like reinforcing material is consecutively laminated to create up to six layers on the surface pattern layer. (Id.). At the same time rib core plates 101 for forming the peripheral ribs having nearly the same shape as the male embossed surface and made of plywood plates, corrugated boards, foam boards, steel sheets, aluminum sheets, resin plates, honeycomb plates, etc. are set at any desired gradient and they are also laminated to form a peripheral rib layer 3 integrated with pattern layer 4 and pattern reinforcing layer 5. (Id.). A reinforcing frame member made of steel or the like is taught to be formed integrally on the upper surface of the pattern reinforcing layer and the grid rib layer. (Paragraph 0025 of the translation).

In stark contrast to the teachings of JP ‘624, claim 1 recites that both the base portion and the reinforcement matrix are molded in one-piece from a non-metallic, non-wooden material. First, JP ‘624 does not teach that the base portion and the reinforcement matrix are molded. Instead a sophisticated lamination process is required in JP ‘624. JP ‘624 requires a variety of materials in its multi-step laminated process. Further, the recited material must be non-metallic and non-wooden, while JP ‘624 teaches the use of plywood plates, corrugated boards, steel sheets, or aluminum sheets as well as a reinforcing frame member made of steel. Thus, claim 1 is patentably distinct.

Application No. 10/735,392
Amendment dated November 30, 2006
Reply to Office Action of November 2, 2006

Docket No.: 66138-0005

Independent claim 24 is also patentably distinct from JP '624. Claim 24 recites that the base portion, having a front face including a pattern and a rear face is formed from a plastic material. JP '624 teaches a variety of other materials being required that are non-plastic in nature. Moreover, even if JP '624 did teach that the base portion were formed from a plastic material, JP '624 teaches directly away from the base portion and the reinforcement matrix being formed from a single material as also recited in the claim. Thus, claim 24 is patentably distinct.

For at least these reasons, independent claims 1 and 24 are patentable over the cited references. Withdrawal of the rejection is respectfully requested. Dependent claims 3-5, 8-11 and 24-27 are patentable by virtue of their dependency on patentable claims 1 or 24. However, the dependent claims also contain additional limitations that are independently patentable. For example, there is no teaching of fiberglass strands as recited in claim 4. Nor is there a teaching of the recitations of claims 9, 10, 24 or 27 as to cavity extension. Withdrawal of the rejection is respectfully requested.

III. Rejection of claim 3 under 35 U.S.C. § 103(a)

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over either of Japanese reference 10-292624 (JP '624) or Sawyer (US 4,150,808) in view of European reference 623,434 (EP '434). From a review of the rejection, however, it appears that the Examiner is actually rejecting claim 4. Moreover, no basis for the use of Sawyer '808 in the rejection is given. In fact, the Examiner states that Sawyer '808 does not appear to specifically disclose a form made of a plastic material that includes a fiberglass strand. Thus, it appears that the Examiner is actually combining JP '624 with EP '434 to make the rejection.

Obviousness cannot be established by combining prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

Application No. 10/735,392
Amendment dated November 30, 2006
Reply to Office Action of November 2, 2006

Docket No.: 66138-0005

MPEP Section 2143 sets forth the basic requirements for the Patent and Trademark Office to establish *prima facie* obviousness as follows: "To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j).

A patent claim is obvious, and thus invalid, when the differences between the claimed invention and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103; *see also Graham v. John Deere Co.*, 383 U.S. 1, 14, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966); *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999). While obviousness is ultimately a legal determination, it is based on several underlying issues of fact, namely: (1) the scope and content of the prior art; (2) the level of skill of a person of ordinary skill in the art; (3) the differences between the claimed invention and the teachings of the prior art; and (4) the extent of any objective indicia of non-obviousness. *See Graham*, 383 U.S. at 17-18. When obviousness is based on the teachings of multiple prior art references, the Examiner must also establish some "suggestion, teaching, or motivation" that would have lead a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed. *See Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1359-60 (Fed. Cir. 1999); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1572 (Fed. Cir. 1996). The Applicant(s) may rebut a *prima facie* showing of obviousness with evidence refuting the Examiner's case or with other objective evidence of nonobviousness. *See WMS Gaming, Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1359 (Fed. Cir. 1999).

Application No. 10/735,392
Amendment dated November 30, 2006
Reply to Office Action of November 2, 2006

Docket No.: 66138-0005

JP '624 does not anticipate or render claim 4 obvious for the reasons discussed above. However, there is no suggestion to combine JP '624 and EP '434. Significantly, EP '434 teaches that it is "see-through" as reflected even in the title itself. The purpose of being able to see through the form is to determine if there are problems with the concrete such as the presence of a gap. (page 3, lines 29-30). JP'624 teaches the importance of having different laminated layers as discussed above. Thus, the problems being solved by the two references are entirely different. Moreover, JP '624 expressly teaches away from using the type of form as recited in EP '434. It talks about issues related to weight, expansion, shrinkage, cracks and adherence as well as assembly when using monolithic plastic forms. See e.g., paragraphs 0003 and 0004 of the translation.

"The examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 47 USPQ2d, at 1458 (Fed. Cir. 1998)

In re Fritch provides that "the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art," and that "the Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." 23 USPQ2d. 1780, at 1783. In focusing efforts to meet this burden, the Federal Circuit concluded that "under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (Emphasis in original).

It is also respectfully submitted that the examiner has not provided adequate motivation for the combination of the references, including sawyer '808, as noted above.

NOV 30 2006

Application No. 10/735,392
Amendment dated November 30, 2006
Reply to Office Action of November 2, 2006

Docket No.: 66138-0005

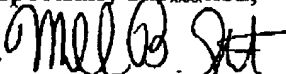
REMARKS

All rejections have been addressed. In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 66138-0005 from which the undersigned is authorized to draw.

Dated: November 30, 2006

Respectfully submitted,

By 

Michael B. Stewart

Registration No.: 36,018

RADER, FISHMAN & GRAUER PLLC

Correspondence Customer Number: 10291

Attorney for Applicant